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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,998	03/27/2001	Ronald P. Sansone	E-984	2015

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/817,998	SANSONE, RONALD P	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 14-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 14-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim 13 has been canceled. Claims 1 and 14 have been amended. Claims 1-12 and 14-27 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 and 14 are identical, which is confusing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-11, 15-16, 19-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being obvious over Kubert et al. (US 2002/0165729) in view of Lint et al. (US 5,636,038) and further in view of Srinivasan (US 6,072,862).

Kuebert et al. teach a method and system for flexible mail delivery, comprising:

Independent Claim.

Claim 1. Depositing with the carrier mail containing the recipient's name and physical address and the sender's name and address [0039]; capturing the name and physical address of the recipient and the sender in the form of an image [0020]; [0031]-[0032]; translating the name and physical address of the recipient into a telephone number [0022]; [0029]; utilizing the telephone number of the recipient to inform the recipient of the availability of the deposited mail [0036]; [0038]; notifying the carrier of the manner in which the recipient would like the mail delivered [0043]; delivering mail to the recipient in the manner specified by the recipient to the carrier [0048]; [0050].

Kuebert et al. do not specifically teach that said informing the recipient of the availability of the deposited mail is utilized via a tactile communication device; and charging the recipient for delivering mail to the recipient.

Lynt et al. teach a method and system for converting visual images into tactile representations for user by a visually impaired person, wherein a printed document is scanned to obtain an image of said document; and said image is processed to provide a Braille representation of said image on a Braille reader. Said Braille reader can be connected to a telephone for providing tactile representations of speech received through the telephone (column 6, lines 15-27).

Srinivasan teaches a method and system for adaptable message delivery, wherein the term "subscriber" obviously indicates charging the recipient for delivering mail to the recipient (column 2, lines 37-58).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include that said informing the recipient of the availability of the deposited mail is utilized via a tactile communication device, as disclosed in Lynt et al., because it would advantageously allow a visually and hearing impaired person to communicate with other persons or businesses.

And it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Kuebert et al. in view of Lynt et al. to include charging the recipient for delivering mail to the recipient, as indicated in Srinivasan, because it would generate funds for business to operate.

Dependent Claims.

Claims 2 and 9. Said method and system, wherein the recipient notifies the carrier to deliver the mail to a specified name and address (Kuebert et al.); [0009]; [0043] (Kuebert et al.).

Claim 3. Notifying the carrier by the recipient to deliver the mail to a specified name and address [0009]; [0043] (Kuebert et al.). Information as to *sender address* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Kuebert et al., Lynt et al. and Srinivasan would be performed the same regardless *if information regarding the specified name and address includes information regarding sender address,* or not.

Claims 4-8. Srinivasan teaches a method and system for adaptable message delivery, wherein the recipient can select the preferred way of getting the mail; said method includes informing the carrier to e-mail or send by facsimile the contents of the mail piece to one or more specified e-mail addresses (column 2, lines 37-58; column 3, lines 4 – column 4, line 7). The motivation to combine Kuebert et al. and Lynt et al. with Srinivasan would be to advantageously allow the recipient to access all his messages via one message

accessing means regardless the form said messages were sent to, as specifically stated in Srinivasan (column 4, lines 56-65).

Claims 10 and 16. Said method and system, wherein the recipient notifies the carrier to hold the mail for a specified period of time [0043] (Kuebert et al.).

Claim 11. Notifying the carrier by the recipient to change the delivery time [0043] (Kuebert et al.). Information as to *slower or faster delivery* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The method steps, disclosed in Kuebert et al., Lynt et al. and Srinivasan would be performed the same regardless *if changing the delivery time includes a slower or faster delivery,* or not.

Claim 15. Said method and system, further including the step of: informing the sender of the delivery of the mail [0042] (Kuebert et al.).

Claims 19-21 and 23-25. Said method and system, wherein the recipient is notified via e-mail, a telephone or facsimile [0036] (Kuebert et al.).

Claim 26. Srinivasan teaches said method and system, wherein the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the mail delivered (column 2, lines 37-58; column 3, lines 4 – column 4, line 7). The motivation to combine Kuebert et al. and Lynt et al. with Srinivasan would be to advantageously allow the recipient to manage the delivery of all his messages via one message accessing means regardless the form said messages were sent to.

Claim 27. Lynt et al. teach said method and system, wherein the recipient is visually impaired (column 6, lines 15-27). The motivation to combine Kuebert et al. with Lynt et al. would be to advantageously allow a visually and hearing impaired person to communicate with other persons or businesses.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al., Lynt et al. and Srinivasan in view of Sherwood et al. (US 6,542,584).

Claim 12 and 14. Kuebert et al., Lynt et al. and Srinivasan teach all the limitations of **claim 12**, except charging the recipient for receiving notification of the availability of the deposited mail.

Sherwood et al. teach a method and system for automatic voice mail redirection, wherein a recipient is charged a fee for receiving a notification that a voice mail message is left for the recipient (column 1, lines 10-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al., Lynt et al. and Srinivasan to include charging the recipient for receiving notification of the availability of the deposited mail as disclosed in Sherwood, because it would generate funds for a business to operate.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al., Lynt et al. and Srinivasan in view of McKeen, Jr. (US 4,037,956).

Claim 17. Kuebert et al., Lynt et al. and Srinivasan teach all the limitations of **claim 17**, except that the recipient notifies the carrier to destroy the mail.

McKeen, Jr. teaches a method and apparatus for verified mail system, wherein the verified content of the recipient mail is destroyed if the recipient does not want to keep it stored (column 2, lines 28-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al., Lynt et al. and Srinivasan to include that the recipient notifies the carrier to destroy the mail as disclosed in McKeen, Jr., because it would advantageously decrease the expenses for handling mail for the post office.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al., Lynt et al. and Srinivasan in view of Gordon et al. (US 6,289,323).

Claim 18. Kuebert et al., Lynt et al. and Srinivasan teach all the limitations of **claim 18**, including sending the contents of the mail piece to one or more specified e-mail addresses, except that the recipient notifies the carrier to recycle the material comprising the mail.

Gordon et al. teach a method and system for a mail delivery including sending the contents of the mail piece to one or more specified e-mail addresses, wherein the mail piece (a postcard) is recycled (column 15, lines 63-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al., Lynt et al. and Srinivasan to include that the recipient notifies the carrier to recycle the material comprising the mail as disclosed in Gordon, because it would advantageously decrease the expenses for handling mail for the post office, and allow to save natural resources.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al., Lynt et al. and Srinivasan in view of Busch et al. (US 6,390,921).

Claim 22. Kuebert et al., Lynt et al. and Srinivasan teach that the recipient is notified via e-mail and a website of the availability of the deposited mail [0036]; [0043] (Kuebert et al.).

Kuebert et al., Lynt et al. and Srinivasan do not specifically teach that the recipient is notified via television of the availability of the deposited mail.

Busch et al. teach a method and system for sharing information in a network environment, wherein a user can receive a message via e-mail, or Web-TV, or telephone, or regular mail delivery (column 4, lines 38-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al., Lynt et al. and Srinivasan to include that the recipient is notified via television as disclosed in Busch et al., because it would advantageously allow to combine the notification service with other TV or WEB related programs, thereby make it more attractive to the customers.

Response to Arguments

Applicant's arguments filed 6/18/2004have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art does not disclose charging the recipient for delivery of mail to the recipient, the examiner stipulates that Srinivasan teaches said method and system for adaptable message delivery, wherein the term "subscriber" (column 2, lines 37-58) obviously indicates receiving services related to the mail delivery on a regular basis. The examiner points out that it is old and well known in "subscription" art to charge for services rendered. Therefore, use of the term "subscriber" obviously indicates charging the recipient for delivery of mail to the recipient, wherein said delivery is provided on a subscription basis.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

8/26/2004

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